

Application No. 10/666,517

Reply to Office Action

*REMARKS/ARGUMENTS**Information Disclosure Statement*

Applicants submitted an Information Disclosure Statement on April 26, 2004. The Information Disclosure Statement was accompanied by Form PTO-1449, which identified references AU-AX. The Office Action dated June 14, 2005 did not include a copy of the Examiner-initialed Form PTO-1449 confirming the Examiner's consideration of references AU-AX. Applicants respectfully request a copy of the Examiner-initialed Form PTO-1449 for completeness sake.

Discussion of the Claim Amendments

Claim 1 has been amended to incorporate the recitation of claim 4 that the fumed alumina particles have a BET surface area of about 30-200 m²/g. Claim 4 has been canceled as superfluous, and claim 5, which previously depended on claim 4, has been amended to depend on claim 1. These amendments are supported by the disclosure as originally filed. No new matter has been added by way of these amendments.

Summary of the Office Action

The Office Action rejects claims 1, 6, 18-24, 26, and 27 as allegedly unpatentable under 35 U.S.C. § 102(e) over U.S. Patent 6,723,397 (Wexler et al.) (hereinafter "the Wexler '397 patent"). The Office Action also rejects claims 1, 6-13, and 18-29 as allegedly unpatentable under 35 U.S.C. § 102(e) over U.S. Patent Application Publication 2004/0001926 A1 (Sharma et al.) (hereinafter "the Sharma '926 publication"). In addition, the Office Action rejects claims 2-5 and 14-17 as allegedly unpatentable under 35 U.S.C. § 103(a) over the Sharma '926 publication.

Discussion of the Section 102 Rejections

As discussed above, the feature of claim 4 has been incorporated into claim 1, from which all of the other pending claims directly or indirectly depend. Claim 4 was not subject to either of the anticipation rejections. Thus, the anticipation rejections have been rendered moot with respect to the pending claims and should be withdrawn.

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Discussion of the Section 103 Rejection

The Sharma '926 publication generally discloses an ink jet recording element comprising a support with an image-receiving layer containing finely divided particulate material and a metal(oxy)hydroxide complex. The image-receiving layer can be formed from an aqueous dispersion coated onto a paper support. The particulate matter can be fumed alumina, and the metal(oxy)hydroxide complex can be a zirconium compound.

As acknowledged in the Office Action, the Sharma '926 publication fails to disclose an aqueous dispersion comprising fumed alumina and a zirconium compound where the fumed alumina particles have a BET surface area between about 30-200 m²/g. Since the claims as amended recite such a BET surface area, the Sharma '926 publication does not disclose the invention as defined by the pending claims.

Indeed, the Sharma '926 publication does not disclose any BET surface area of the fumed alumina, much less the BET surface area recited in the pending claims. The Office Action alleges that BET surface area is a variable which can be adjusted to obtain the desired transparency and imaging properties of the coating layer and that one of skill in the art would be motivated to utilize routine experimentation to determine the optimal BET surface area for specific applications. The Sharma '926 publication, however, fails to provide any guidance whatsoever to one of ordinary skill in the art regarding BET surface area. As a result, one of ordinary skill in the art would have no motivation to consider modifying BET surface area based on the disclosure of the Sharma '926 publication.

As is well-settled, the mere fact that it may be obvious to try certain modifications in an effort to improve a product is not a sufficient basis to support an obviousness rejection. *See, e.g., In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987) ("[O]ne skilled in the art might find it obvious to try various combinations of these known...agents. However, this is not the standard of 35 U.S.C. § 103."). Therefore, the obviousness rejection based on the Sharma '926 publication is improper and should be withdrawn.

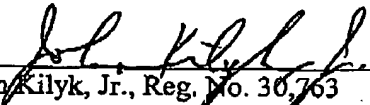
Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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